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EXAMINER	
GAY, JENNIFER HAWKINS	

ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/044,639	AKERLUND, TOR JAN	
	Examiner	Art Unit	
	Jennifer H Gay	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/20/03,12/24/03*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24 and 35-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24 and 35-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 53-56 are objected to because of the following informalities: claims 53 and 55 are identical as are claims 54 and 56. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 38-49 and 60-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation that the center of mass of the tong is substantially aligned with an axis of the extendable boom is not found in the specification or the drawings. Though applicant has indicated that this feature is shown in Figure 4, the examiner does not believe that Figure 4 shows such a feature nor is such a feature referred to in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-24, and 35-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Swoboda, Jr. et al. (US 3,840,128).

Regarding claim 1: Swoboda, Jr. et al. discloses an apparatus for positioning a wellbore tubular gripping assembly. The apparatus includes the following features:

- A cantilevered extendable boom **36** with the gripping assembly **52** attached to the end thereof.
- An actuating member (5:35-40) for extending and retracting the extendable boom.
- A mounting assembly **80** coupled to an opposite end of the boom.

Regarding claim 2: The boom is telescopic (Figure 2).

Regarding claims 3 and 18: The boom is pivotable about a vertical axis (8:7-9).

Regarding claims 4 and 19: The boom is pivotable about a horizontal axis via a pivot point **118**.

Regarding claims 5 and 15: The boom includes an outer barrel **38** and an inner barrel **42**.

Regarding claims 6 and 16: The boom includes an intermediate barrel **40**.

Regarding claims 7 and 17: As shown in Figure 2, a portion of the inner barrel is slidably mounted in the intermediate barrel and a portion of the intermediate barrel is slidably mounted in the outer barrel.

Regarding claims 8 and 12: The mounting assembly includes a base **82** and a carriage **70** that is pivotally attached to the base. As shown in Figure 2, a portion of the outer barrel is disposed in the carriage.

Regarding claims 9 and 24: The gripping assembly is movably attached to the inner barrel via pivot points **72, 78**.

Regarding claims 10 and 13: As shown in Figures 11 and 12, the outer barrel is secured to the carriage via a clamping assembly.

Regarding claim 11: As stated in column 8, lines 37-64, the outer barrel is extendable relative to the carriage thus the outer barrel would be extendable relative to the clamping assembly.

Regarding claim 14: Though not specifically disclosed, the clamping assembly would inherently be releasable connected to the carriage in order to have been able to disassemble the apparatus for maintenance.

Regarding claim 20: The apparatus includes a motor **90** to adjust the position of the boom relative to the mounting assembly.

Regarding claim 21: The actuating member includes a piston and cylinder assembly (5:35-40, Figure 11).

Regarding claim 22: As seen in Figure 11, the piston and cylinder assembly is at least partially located on the boom.

Regarding claim 23: The piston and cylinder assembly is used to move the boom horizontally.

Regarding claim 35: Swoboda, Jr. et al. discloses an apparatus for positioning a wellbore tubular gripping assembly. The apparatus includes the following features:

- A cantilevered extendable boom **36** with the gripping assembly **52** attached to the end thereof.
- An motive assembly (5:35-40) for extending and retracting the extendable boom.
- A mounting assembly **80** coupled to an opposite end of the boom.

Regarding claim 36: The gripping assembly is movably attached to the inner barrel via pivot points **72, 78**.

Regarding claim 37: The motive assembly includes a piston and cylinder assembly (5:35-40, Figure 11).

Regarding claim 38: Swoboda, Jr. et al. discloses an apparatus for positioning a wellbore tubular gripping assembly. The apparatus includes the following features:

- A cantilevered extendable boom **36** with the gripping assembly **52** attached to the end thereof. As seen in Figure 2, 9, and 10, the center of mass of the gripping assembly is aligned with the central axis of the boom.
- An actuating member (5:35-40) for extending and retracting the extendable boom.
- A mounting assembly **80** coupled to an opposite end of the boom.

Regarding claim 39: The boom is telescopic (Figure 2).

Regarding claim 40: The boom is pivotable about a vertical axis (8:7-9).

Regarding claim 41: The boom is pivotable about a horizontal axis via a pivot point **118**.

Regarding claim 42: The boom includes an outer barrel **38** and an inner barrel **42**.

Regarding claim 43: The boom includes an intermediate barrel **40**.

Regarding claim 44: The mounting assembly includes a base **82** and a carriage **70** that is pivotally attached to the base. As shown in Figure 2, a portion of the outer barrel is disposed in the carriage.

Regarding claim 45: As shown in Figures 11 and 12, the outer barrel is secured to the carriage via a clamping assembly.

Regarding claim 46: Though not specifically disclosed, the clamping assembly would inherently be releasable connected to the carriage in order to have been able to disassemble the apparatus for maintenance.

Regarding claim 47: The apparatus includes a motor **90** to adjust the position of the boom relative to the mounting assembly.

Regarding claim 48: The actuating member includes a piston and cylinder assembly (5:35-40, Figure 11). As seen in Figure 11, the piston and cylinder assembly is at least partially located on the boom.

Regarding claim 49: The piston and cylinder assembly is used to move the boom horizontally.

Regarding claim 50: Swoboda, Jr. et al. discloses an apparatus for positioning a wellbore tubular gripping assembly. The apparatus includes the following features:

- A cantilevered extendable boom **36** with the gripping assembly **52** attached to the end thereof.
- An motive assembly (5:35-40) for extending and retracting the extendable boom.
- A mounting assembly **80** coupled to an opposite end of the boom.

Regarding claim 51: The gripping assembly is movably attached to the inner barrel via pivot points **72, 78**.

Regarding claim 52: The motive assembly includes a piston and cylinder assembly (5:35-40, Figure 11).

Regarding claims 53 and 55: The boom is movable in a vertical plane (8:7-9) and a horizontal plane via a pivot point **118**.

Regarding claims 54 and 56: The boom is slidable along the mounting assembly between a first and second position.

Regarding claim 57: The boom is telescopic.

Regarding claim 58: Swoboda, Jr. et al. discloses a method for position a wellbore tubular gripping assembly. The method involves the following steps:

- Providing an extendable boom **36** having a variable length.
- Attaching the gripping assembly **52** to a first end of the boom.
- Coupling a second end of the boom to a mounting assembly **80**.
- Moving the gripping assembly between a first and second position.

Regarding claim 59: The boom is telescopic.

Regarding claims 60 and 61: As seen in Figure 2, 9, and 10, the center of mass of the gripping assembly is aligned with the central axis of the boom.

Regarding claim 62: Swoboda, Jr. et al. discloses gripping assembly that includes the following features:

- An extendable boom **36**.
- A gripping assembly **52** mounted to one end of the boom.
- As seen in Figure 2, 9, and 10, the center of mass of the gripping assembly is aligned with the central axis of the boom.

Regarding claim 63: Swoboda, Jr. et al. discloses an apparatus for positioning a wellbore tubular gripping assembly. The apparatus includes the following features:

- A cantilevered extendable boom **36** with the gripping assembly **52** attached to the end thereof.
- An motive assembly (5:35-40) for extending and retracting the extendable boom.
- A mounting assembly **80** coupled to an opposite end of the boom.

Allowable Subject Matter

6. The indicated allowability of claim 11 is withdrawn in view of the newly discovered reference(s) to Swoboda, Jr. et al. Rejections based on the newly cited reference(s) is given above.

Response to Arguments

7. Applicant's arguments with respect to claims 1-10, 12-24, and 35-63 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Bagnell
Supervisory Patent Examiner
Art Unit 3672

JHG
March 26, 2004